

Attorney Docket No.: ISPH-0614
Inventors: Wu et al.
Serial No.: 09/992,738
Filing Date: November 14, 2001
Page 7

REMARKS

Claims 1-42 are pending in the instant application. Claims 20-42 have been withdrawn from consideration. Claims 11-13 have been allowed. Claims 1-10 and 14-19 have been rejected. Claims 2-9 and 14-42 have been canceled. Claims 1 and 11 have been amended. No new matter has been added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Sequence Listing

The Examiner has suggested that the sequence of Figure 1A is not included in the sequence disclosure and its identity is also unclear based on the description in the specification as filed. The Examiner also suggests that the identity of sequences 1 and 2 in the sequence listing are not identified. Applicants have filed herewith a new sequence listing as required wherein the sequences of Figure 1 are included in the listing. Further, the specification has been amended to include a more clear description of Figure 1 and a replacement Figure 1 has been provided.

Attorney Docket No.: **ISPH-0614**
Inventors: **Wu et al.**
Serial No.: **09/992,738**
Filing Date: **November 14, 2001**
Page 8

II. Restriction Requirement

The Restriction Requirement wherein claims 1-19 were placed into Group I, claims 20 and 21 into Group II, claims 22-29 into Group III, claims 30-33 into Group IV, and claims 34-42 into Group V, has been deemed proper and made Final. Accordingly, Applicants have canceled claims 20-42, reserving the right to file continuing applications on the canceled subject matter.

III. Objection to the Disclosure

The Examiner has objected to the disclosure for containing certain informalities. However, Applicants do not see what informalities in particular the Examiner is pointing to as Figure 1A clearly shows a "Q" at position 186 as listed at page 7. Regardless, Applicants have provided herewith a correct Figure 1 where the residues are more clearly labeled. Withdrawal of this objection is respectfully requested.

IV. Rejection of Claims Under 35 U.S.C. 112, Second Paragraph

Claims 4, 5, 7, 11 and 17 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner suggests that claims 4 and 5 are indefinite in recitation of the SEQ ID NO.

Attorney Docket No.: ISPH-0614
Inventors: Wu et al.
Serial No.: 09/992,738
Filing Date: November 14, 2001
Page 9

they correspond to, while claims 7 and 11 are indefinite in recitation of the parentheses. Claim 17 is suggested to be confusing and indefinite in recitation of "the cleavage pattern is broader than that of a wild-type human RNase H1". Applicants have either canceled these claims or amended these claims to make the language of the claims more clear. Withdrawal of this rejection is respectfully requested.

V. Rejection of Claims Under 35 U.S.C. 112, First Paragraph

Claims 1-4, 6-10 and 14-19 have been rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner acknowledges that the specification is enabling for compositions and methods involving a human H1 enzyme retaining activity by changing Lys to Ala at both positions 226 and 227, deleting all of region I or II, or deleting all of regions I and II. However, the Examiner suggests the specification is not enabling for any and all mutations as it would not be known if a mutation is successful until the change is actually made. Applicants respectfully traverse this rejection.

At the outset, Applicants have amended the claims to recite

Attorney Docket No.: **ISPH-0614**
Inventors: **Wu et al.**
Serial No.: **09/992,738**
Filing Date: **November 14, 2001**
Page 10

that the mutations of the RNase H1 polypeptide consist of the Lys-to-Ala substitutions at positions 226 and 227, the deletion of region I or region II, or the deletion of regions I and II, mutations that were acknowledged by the Examiner to be enabled in the specification as filed. Accordingly, the amended claims are enabled by the teachings in the specification as filed and meet the requirements of 35 U.S.C. 112, first paragraph. Withdrawal of this rejection is respectfully requested.

VI. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

Jane Massey Licata

Jane Massey Licata
Registration No. 32,257

Date: **March 31, 2004**

Licata & Tyrrell P.C.
66 E. Main Street
Marlton, NJ 08053

856-810-1515